

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 814072260 US on the date shown below in a box addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: June 22, 2010 Signature: Diane Blevins

(Diane Blevins)

Patent

Docket No. 532212000624



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas L. CANTOR et al.

Serial No.: 10/760,091

Filing Date: January 16, 2004

For: METHODS FOR DIFFERENTIATING
AND MONITORING PARATHYROID
AND BONE STATUS RELATED
DISEASES

Examiner: C. Cheu

Group Art Unit: 1641

Confirmation No.: 2110

SUPPLEMENTAL INFORMATION DISCLOSURE STATEMENT UNDER MPEP § 724.02

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Pursuant to the duty of disclosure in 37 C.F.R. § 1.56, Applicants hereby submit under MPEP § 724.02 the four documents listed on the attached Form PTO/SB/08a/b. The attention of the Patent and Trademark Office is hereby directed to these documents because they are **SUBJECT TO PROTECTIVE ORDER**. It is respectfully requested that the Examiner consider the information during the prosecution of this application.

The four documents listed on the attached Form PTO/SB/08a/b are **SUBJECT TO PROTECTIVE ORDER** and should only be viewed by the Examiner or other authorized Patent and Trademark Office Employees. Pursuant to MPEP § 724.02, a copy of each document that is

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02 FC:1806

180.00 DA

sd-506486

EXHIBIT D

Serial No. 10/760,091

SUBJECT TO PROTECTIVE ORDER listed on the attached Form PTO/SB/08a/b is enclosed in a sealed, clearly labeled envelope. These documents have not otherwise been made public.

The documents are from *Scantibodies Laboratory, Inc. v. Immunotopics, Inc.*, at the United States Court of Appeals for the Federal Circuit, Case No. 2009-1481. This litigation involves U.S. Patent No. 6,689,566. The present application is a Continuation of U.S. Patent No. 6,743,590, which is a Continuation-in-Part of U.S. Patent No. 6,689,566. Scantibodies Laboratory, Inc. is the assignee of the present application.

This Information Disclosure Statement is submitted:

- ☐ With the application; accordingly, no fee or separate requirements are required.
- ☐ Before the mailing of a first Office Action after the filing of a Request for Continued Examination under § 1.114. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☐ Within three months of the application filing date or before mailing of a first Office Action on the merits; accordingly, no fee or separate requirements are required. However, if applicable, a certification under 37 C.F.R. § 1.97 (e)(1) has been provided.
- ☒ After receipt of a first Office Action on the merits but before mailing of a final Office Action or Notice of Allowance.
 - ☐ A fee is required. A check in the amount of ___ is enclosed.
 - ☒ A fee is required. Accordingly, a Fee Transmittal form (PTO/SB/17) is attached to this submission.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above; accordingly; no fee is believed to be due.
- ☐ After mailing of a final Office Action or Notice of Allowance, but before payment of the issue fee.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a check in the amount of ___ is enclosed.
 - ☐ A Certification under 37 C.F.R. § 1.97(e) is provided above and a Fee Transmittal form (PTO/SB/17 is attached to this submission.)

Applicants would appreciate the Examiner initialing and returning the Form PTO/SB/08a/b, indicating that the information has been considered and made of record herein.

The information contained in this Information Disclosure Statement under 37 C.F.R. § 1.97 and § 1.98 is not to be construed as a representation that: (i) a complete search has been made; (ii) additional information material to the examination of this application does not exist; (iii) the information, protocols, results and the like reported by third parties are accurate or enabling; or (iv) the above information constitutes prior art to the subject invention.

In the unlikely event that the transmittal form is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing 532212000624.

Dated: June 22, 2010

Respectfully submitted,

By 

Peng Chen

Registration No.: 43,543

MORRISON & FOERSTER LLP

12531 High Bluff Drive, Suite 100

San Diego, California 92130-2040

(858) 720-5117



ALTERNATIVE TO PTO/SB/08A/B
(Based on PTO 01-08 version)

INFORMATION DISCLOSURE STATEMENT BY APPLICANT (Use as many sheets as necessary)		Complete if Known	
		Application Number Filing Date First Named Inventor Art Unit Examiner Name Attorney Docket Number	10/760,091 January 16, 2004 Thomas L. CANTOR 1641 C. Cheu 532212000624
Sheet	1	of	1

NON PATENT LITERATURE DOCUMENTS – SUBJECT TO PROTECTIVE ORDER			
Examiner Initials	Cite No.	Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published.	T ²
	1.	Confidential Brief for Defendants-Appellees, filed December 22, 2009, United States Court of Appeals for the Federal Circuit, Case No. 2009-1481	
	2.	Corrected Confidential Brief for Defendants-Appellees, filed January 8, 2010, United States Court of Appeals for the Federal Circuit, Case No. 2009-1481	
	3.	Confidential Joint Appendix, Vol. 1, filed January 22, 2010, United States Court of Appeals for the Federal Circuit, Case No. 2009-1481	
	4.	Confidential Joint Appendix, Vol. 2, filed January 22, 2010, United States Court of Appeals for the Federal Circuit, Case No. 2009-1481	

Examiner Signature	Date Considered
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*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

¹Applicant's unique citation designation number (optional). ²Applicant is to place a check mark here if English language Translation is attached.

06-24-10

DA

I hereby certify that this paper is being deposited with the U.S. Postal Service as Express Mail, Airmail No. EV 814072260 US on the date shown below in a box addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: June 22, 2010 Signature: *Diane Blivins*

(Diane Blivins)

Patent

Docket No. 532212000624

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Thomas L. CANTOR et al.

Serial No.: 10/760,091

Filing Date: January 16, 2004

For: METHODS FOR DIFFERENTIATING
AND MONITORING PARATHYROID
AND BONE STATUS RELATED
DISEASES

Examiner: C. Cheu

Group Art Unit: 1641

Confirmation No.: 2110

PETITION TO EXPUNGE INFORMATION
UNDER 37 C.F.R. § 1.59 (b)

MS Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

Pursuant to 37 C.F.R. § 1.59(b) and MPEP § 724, Applicants hereby petition the Commissioner to have the four documents submitted in the above-identified application with the Supplemental Information Disclosure Statement filed under MPEP § 724.02 on June 22, 2010 expunged upon allowance or abandonment of this application.

Pursuant to MPEP § 724.05(A) and (B), Applicants believe expungement of the information is appropriate for the four documents listed on the attached Form PTO/SB/08a/b because they are **SUBJECT TO PROTECTIVE ORDER**. The documents are from *Scantibodies Laboratory, Inc. v. Immunotopics, Inc.*, Case No. 2009-1481 at the United States Court of Appeals for Federal Circuit. The information has not otherwise been made public.

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Applicants acknowledge that upon the grant of this petition and return of the documents that are **SUBJECT TO PROTECTIVE ORDER**, Applicants will preserve the documents for the entire term of the patent in accordance with MPEP § 724.05 (C). Please return the documents to the undersigned upon allowance, issue, or abandonment of this application.

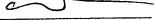
Pursuant to MPEP § 725.05 (D), Applicants hereby state that this petition is being submitted by, or on the behalf of, the party in interest who originally submitted the information.

Pursuant to MPEP § 725.05 (E), the Commissioner is hereby authorized to charge the required fee under 37 C.F.R. § 1.17(g) for a petition under 37 C.F.R. § 1.59(b) to Deposit Account No. 03-1952 referencing docket no. 532212000624. Fee Transmittal (form PTO/SB/17p) is attached.

In the unlikely event that the transmittal form is separated from this document and the U.S. Patent and Trademark Office determines that an extension and/or other relief (such as payment of a fee under 37 C.F.R. § 1.17 (p)) is required, Applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petition and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 532212000624.

Dated: June 22, 2010

Respectfully submitted,

By 
Peng Chen
Registration No.: 43,543
MORRISON & FOERSTER LLP
12531 High Bluff Drive, Suite 100
San Diego, California 92130-2040
(858)720-5117



Approved for use through 07/31/2012. OMB 0651-0031
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

Total Number of Pages in This Submission

10

Application Number

10/760,091

Filing Date

January 16, 2004

First Named Inventor

Thomas L. CANTOR

Art Unit

1641

Examiner Name

C. Cheu

Attorney Docket Number

532212000624

ENCLOSURES (Check all that apply)

☒ Fee Transmittal Form (1 page)

☐ Fee Attached

☐ Amendment/Reply

☐ After Final

☐ Affidavits/declaration(s)

☐ Extension of Time Request

☐ Express Abandonment Request

☒ Information Disclosure Statement
(Supplemental - 3 pages)

☐ Certified Copy of Priority
Document(s)

☐ Reply to Missing Parts/
Incomplete Application

☐ Reply to Missing Parts under
37 CFR 1.52 or 1.53

☐ Drawing(s)

☐ Licensing-related Papers

☒ Petition to Expunge (2 pages)

☐ Petition to Convert to a
Provisional Application

☐ Power of Attorney, Revocation
Change of Correspondence Address

☐ Terminal Disclaimer

☐ Request for Refund

☐ CD, Number of CD(s) _____

☐ Landscape Table on CD

☐ After Allowance Communication
to TC

☐ Appeal Communication to Board
of Appeals and Interferences

☐ Appeal Communication to TC
(Appeal Notice, Brief, Reply Brief)

☐ Proprietary Information

☐ Status Letter

☒ Other Enclosure(s) (please
Identify below):

Petition Fee for \$200.00 (1 page)
Form PTO/SB/08A/B (1 page, plus
duplicate)

4 References, placed in separate
envelopes and appropriately
labeled

Return Receipt Postcard

Remarks

CUSTOMER NO. 25225

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name

MORRISON & FOERSTER LLP

Signature

Printed name

Peng Chen

Date

June 22, 2010

Reg. No.

43,543

I hereby certify that this paper and the accompanying documents are being deposited with the U.S. Postal Service as Express Mail, Airbill
No. EV 814072280 US, on the date shown below in a box addressed to:
MS Amendment, Commissioner for Patents, P.O. Box 1650, Alexandria, VA 22313-1450.

Dated: June 22, 2010

Signature: _____

(Diane Blevins)



Approved for use through 06/30/2010. OMB 0651-0032
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no person are required to respond to a collection of information unless it displays a valid OMB control number

<p>Effective on 12/8/2004. Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).</p> <h2 style="text-align: center;">FEE TRANSMITTAL</h2> <h3 style="text-align: center;">For FY 2009</h3>		<p>Complete if Known</p> <p>Application Number 10/760,091</p> <p>Filing Date January 16, 2004</p> <p>First Named Inventor Thomas L. CANTOR</p> <p>Examiner Name C. Cheu</p> <p>Art Unit 1641</p> <p>Attorney Docket No. 532212000624</p>	
<input checked="" type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27			
TOTAL AMOUNT OF PAYMENT	(S) 180.00		

METHOD OF PAYMENT (check all that apply)

☐ Check
 ☐ Credit Card
 ☐ Money Order
 ☐ None
 ☐ Other (please identify): _____

☒ Deposit Account
 Deposit Account Number: 03-1952
 Deposit Account Name: Morrison & Foerster LLP

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☒ Charge fee(s) indicated below
 ☐ Charge fee(s) indicated below, except for the filing fee

☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17
 ☒ Credit any overpayments

FEE CALCULATION

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	330	165	540	270	220	110	
Design	220	110	100	50	140	70	
Plant	220	110	330	165	170	85	
Reissue	330	165	540	270	650	325	
Provisional	220	110	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	52	26
Each independent claim over 3 (including Reissues)	220	110
Multiple dependent claims	390	195

Total Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)** **Multiple Dependent Claims**
 - 20 or HP x = **Fee (\$)** **Fee Paid (\$)**

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**
 - 3 or HP x =

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(c)), the application size fee due is \$270 (\$135 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
- 100 =	/50 =	(round up to a whole number) x	=	

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Other (e.g., late filing surcharge): 1806 Submission of an Information Disclosure Statement 180.00

SUBMITTED BY Signature _____		Registration No. (Attorney/Agent) 43,543	Telephone (858) 720-5117
Name (Print/Type) Peng Chen		Date	June 22, 2010



Under the Paperwork Reduction Act of 1995, no person is required to respond to a collection of information unless it displays a valid OMB control number.

PETITION FEE
Under 37 CFR 1.17(f), (g) & (h)
TRANSMITTAL
(Fees are subject to annual revision)

Send completed form to: Commissioner for Patents
P.O. Box 1450, Alexandria, VA 22313-1450

Application Number	10/760,091
Filing Date	January 16, 2004
First Named Inventor	Thomas L. CANTOR
Art Unit	1641
Examiner Name	C. Cheu
Attorney Docket Number	532212000624

Enclosed is a petition filed under 37 CFR 1.59 that requires a processing fee (37 CFR 1.17(f), (g), or (h)). Payment of \$ 200.00 is enclosed.

This form should be included with the above-mentioned petition and faxed or mailed to the Office using the appropriate Mail Stop (e.g., Mail Stop Petition), if applicable. For transmittal of processing fees under 37 CFR 1.17(i), see form PTO/SB/17i.

Payment of Fees (small entity amounts are NOT available for the petition fees).

- ☒ The Commissioner is hereby authorized to charge the following fees to Deposit Account No. 03-1952 :
☒ petition fee under 37 CFR 1.17(f), (g) or (h) ☒ any deficiency of fees and credit of any overpayments
- ☐ Check in the amount of \$ _____ is enclosed.
- ☐ Payment by credit card (Form PTO-2038 or equivalent enclosed). Do not provide credit card information on this form.

Petition Fees under 37 CFR 1.17(f): Fee \$400 Fee Code 1462

For petitions filed under:

- § 1.136(a) – for revocation of a power of attorney by fewer than all applicants
- § 1.53(e) – to accord a filing date.
- § 1.57(a) – to accord a filing date.
- § 1.162 – for decision on a question not specifically provided for.
- § 1.183 – to suspend the rules.
- § 1.378(e) – for reconsideration of decision on petition refusing to accept delayed payment of maintenance fee in an expired patent.
- § 1.741(b) – to accord a filing date to an application under § 1.740 for extension of a patent term.

Petition Fees under 37 CFR 1.17(g): Fee \$200 Fee Code 1463

For petitions filed under:

- § 1.12 – for access to an assignment record.
- § 1.14 – for access to an application.
- § 1.47 – for filing by other than all the inventors or a person not the inventor.
- § 1.59 – for expungement of information.
- § 1.103(a) – to suspend action in an application.
- § 1.136(b) – for review of a request for extension of time when the provisions of section 1.136(a) are not available.
- § 1.295 – for review of refusal to publish a statutory invention registration.
- § 1.296 – to withdraw a request for publication of a statutory invention registration filed on or after the date the notice of intent to publish issued.
- § 1.377 – for review of decision refusing to accept and record payment of a maintenance fee filed prior to expiration of a patent.
- § 1.550(c) – for patent owner requests for extension of time in ex parte reexamination proceedings.
- § 1.956 – for patent owner requests for extension of time in inter partes reexamination proceedings.
- § 5.12 – for expedited handling of a foreign filing license.
- § 5.15 – for changing the scope of a license.
- § 5.25 – for retroactive license.

Petition Fees under 37 CFR 1.17(h): Fee \$130 Fee Code 1464

For petitions filed under:

- § 1.19(g) – to request documents in a form other than that provided in this part.
- § 1.84 – for accepting color drawings or photographs.
- § 1.91 – for entry of a model or exhibit.
- § 1.102(d) – to make an application special.
- § 1.138(c) – to expressly abandon an application to avoid publication.
- § 1.313 – to withdraw an application from issue.
- § 1.314 – to defer issuance of a patent.

Signature

Peng Chen

Typed or printed name

June 22, 2010

Date

43,543

Registration No., if applicable



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

MORRISON & FOERSTER LLP
12531 HIGH BLUFF DRIVE
SUITE 100
SAN DIEGO CA 92130-2040

JUL - 1 2010

In re Application of:
Cantor et al.
Serial No.: 10/760,091
Filed: January 16, 2004
Attorney Docket No.: 532212000624

: PETITION DECISION


This is in response to the petition under 37 CFR § 1.59(b), filed June 22, 2010, to expunge information from the above identified application. This application has not been allowed.

Petitioner requests that Supplemental Information Disclosure Statement having four documents therein submitted to the Patent Office on June 22, 2010, be expunged from the record. Petitioner states either: (A) that the information contains trade secret material, proprietary material and/or material that is subject to a protective order which has not been made public; or (B) that the information submitted was unintentionally submitted and the failure to obtain its return would cause irreparable harm to the party who submitted the information or to the party in interest on whose behalf the information was submitted, and the information has not otherwise been made public. The petition fee set forth in 37 CFR § 1.17(g) has been paid.

This is an examined application which is currently under non-final rejection. As such the information provided has been reviewed, in part, but proceedings in the application have not been terminated. As stated in M.P.E.P. 724, upon allowance or other action closing prosecution in an application, petition may be made for return of Proprietary information. The information cannot be expunged at this time.

The petition is **DISMISSED**. Petitioner may resubmit the petition subsequent to a Notice of Allowability or *ex parte* Quayle action being mailed in the application. No additional petition fee will be required at that time.

Should there be any questions about this decision please contact Marianne C. Seidel by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0584 or by facsimile sent to the general Office facsimile number, 571-273-8300.


Marianne C. Seidel
Quality Assurance Specialist
Technology Center 1600